

REMARKS/ARGUMENTS

Initially, Applicant would like to express appreciation to the Examiner for the detailed Official Action provided. However, Applicant notes that the Examiner still has not acknowledged that the drawings are acceptable, and it is requested that the Examiner indicate the same in the next Official Action.

Applicant submits that the instant amendment is proper for entry after final rejection. Applicant notes that no question of new matter nor are any new issues raised in entering the instant amendment of the claims and that no new search would be required.

Moreover, Applicant submits that the instant amendment places the application in condition for allowance, or at least in better form for appeal.

Accordingly, Applicant requests that the Examiner enter the instant amendment, consider the merits of the same, and indicate the allowability of the present application and each of the pending claims.

Upon entry of the above amendments claims 9 and 10 will have been added. Claims 1-10 are currently pending. Applicant notes that newly-added claims 9-10 generally correspond to original claims 2 and 6 (i.e., rewritten in independent form), respectively. Applicant respectfully requests reconsideration of the outstanding rejections, and allowance of all the claims pending in the present application.

In the Official Action, the Examiner has rejected claims 1-8 under 35 U.S.C. § 103(a) as being unpatentable over newly-cited WOLTER (U.S. Patent Pub. No. 2003/0129559) in view of VALENTINO (U.S. Patent No. 5,673,802) and

CARPENTER (U.S. Patent No. 6,554,448).

Applicant respectfully traverses the above-noted rejection. In this regard, Applicant notes that WOLTER, VALENTINO and CARPENTER, alone or in any proper combination, fail to teach or suggest the combination of elements as recited in claim 1. In particular, claim 1 sets forth a cake decorating device including, inter alia, a heating unit mounted to the base to emit heat; and a display provided on a vertical wall of the base and including a previously printed thermosensitive message, wherein heat emitted from the heating unit causes a color change of the message, such that the display displays the message.

Applicant submits that WOLTER, VALENTINO and CARPENTER, alone or in any proper combination, lack any disclosure of at least the above-noted combination of elements.

In this regard, the Examiner asserts that WOLTER discloses the general structure of a cake decorating device. However, the Examiner acknowledges that WOLTER does not disclose pins that extend into the cake or a thermo-sensitive message which changes color as a result of heat emitted from a heating unit (see, paragraph 3 of the Official Action). Nevertheless, the Examiner takes the position that it would have been obvious to one of ordinary skill in the art to supply the acknowledged deficiencies of WOLTER with the purported teachings of VALENTINO and CARPENTER. More particularly, the Examiner asserts that CARPENTER teaches a thermo-sensitive message which changes color as a result of heat emitted from a candle (see, paragraph 3 of the Official Action).

However, contrary to the Examiner's assertions, the design 12 (as disclosed in CARPENTER is attached to a candle holder 1 which surrounds a candle 25. Thus, it would appear that the proximity of the design 12 to the candle 25, and the fact that the candle 25 is surrounded by the candle-holder 1, makes it possible for the candle 25 of CARPENTER to generate enough heat to effect a change in the color of the design disclosed in CARPENTER (see, Column 8, lines 3-11, of CARPENTER). In this regard, the Examiner has not demonstrated that replacing the design illustrated in WOLTER (see, Figure 4), with the thermo-sensitive design disclosed in CARPENTER, is enough to effect a color change of the WOLTER design. That is, the Examiner has provided no evidence that the candles 16 disclosed in WOLTER are of the type, or are in a close enough proximity to the design, to effect a color change. Therefore, the Examiner has not demonstrated that there would be a reasonable expectation of success in combining the purported teachings of WOLTER, CARPENTER and VALENTINO.

In this regard, the Examiner is reminded that "to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both

be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In this regard, Applicant submits that the Examiner is relying on Applicant's own disclosure to provide a reasonable expectation of success. Thus, WOLTER, CARPENTER and VALENTINO, alone or in any proper combination, fail to disclose at least a heating unit mounted to the base to emit heat; and a display provided on a vertical wall of the base and including a previously printed thermosensitive message, wherein heat emitted from the heating unit causes a color change of the message, such that the display displays the message.

A further feature of a non-limiting embodiment of the present disclosure, as recited in dependent claim 6, sets forth a cake decorating device including, inter alia, a candle-receiving chamber integrated with the base; and a candle having a plurality of candlewicks and received in the candle-receiving chamber.

Applicant submits that WOLTER, VALENTINO and CARPENTER, alone or in any proper combination, lack any disclosure of at least the above-noted combination of elements.

In this regard, the Examiner acknowledges that WOLTER, VALENTINO and CARPENTER do not disclose the candle-receiving chamber integrated with the base; and a candle having a plurality of candlewicks and received in the candle-receiving chamber (see, Page 4, paragraph 4). Nevertheless, the Examiner asserts that it would have been obvious to supply the deficiencies WOLTER, VALENTINO and CARPENTER as a matter of integration of parts (see, Page 4, paragraph 6). However, Applicant submits that the Examiner has

not provided any factual evidence to support the aforementioned assertion. Further, Applicant respectfully requests that, should the Examiner decide to maintain the above-noted rejection, the Examiner provide an appropriate teaching reference indicating the same.

In regard to claim 8, the Examiner acknowledges that the applied prior art does not disclose the displaying unit comprising a transfer paper printed by a thermosensitive microcapsule product, as recited in claim 8. Nevertheless, the Examiner asserts that it would have been obvious to one of ordinary skill in the art to utilize any process. However, the Examiner is reminded that "[t]o establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). In this regard, Applicant submits that the Examiner has not provided any factual evidence to support the assertion that having the displaying unit comprised of a transfer paper printed by a thermosensitive microcapsule product is an obvious modification. Accordingly, the rejection of claims 1-8 under 35 U.S.C. § 103(a) is improper and should be withdrawn.

In regard to new independent claims 9 and 10, Applicant submits that these claims recite additional features of the presently claimed invention. Support for new independent claims 9 and 10 can be found in at least Figures 1

and 8 of the drawings. Accordingly, no new matter is believed to be added by the present amendment.

Further, Applicant also expressly incorporates all other arguments made in Applicant's previous Response.

In view of the arguments herein, Applicant submits that independent claims 1, 9 and 10 are in condition for allowance. With regard to dependent claims 2-8, Applicant asserts that they are allowable on their own merit, as well as because they depend from independent 1, which Applicant has shown to be allowable. Further, all dependent claims recite additional features which further define the present invention over the references of record.

Thus, it is respectfully submitted that all of the claims in the present application are clearly patentable over the references cited by the Examiner, either alone or in combination, and an indication to such effect is respectfully requested, in due course.

### SUMMARY

Applicant submits that the present application is in condition for allowance, and respectfully requests an indication to that effect. Applicant has argued the allowability of the claims and pointed out deficiencies of the applied reference. Accordingly, reconsideration of the outstanding Official Action and allowance of the present application and all the claims therein are respectfully requested and is now believed to be appropriate.

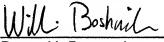
Applicant notes the status of the present application as being an after final rejection and with respect to such status believes that there is a clear basis for the entry of the present amendment consistent with 37 C.F.R. § 1.116. Applicant notes amendments after final are not entered as a matter of right; however, Applicant submits that the present amendment does not raise the question of new matter. Moreover, the present amendment clearly places the present application in condition for allowance.

Applicant notes that this amendment is being made to advance prosecution of the application to allowance and should not be considered as surrendering equivalents of the territory between the claims prior to the present amendment and the amended claims. Further, no acquiescence as to the propriety of the Examiner's rejection is made by the present amendment. All other amendments to the claims which have been made in this amendment, and which have not been specifically noted to overcome a rejection based upon the prior art, should be considered to have been made for a purpose unrelated to patentability, and no estoppel should be deemed to attach thereto.

Should the Examiner have any questions, the Examiner is invited to contact the undersigned at the below-listed telephone number.

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